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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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CORNING INCORPORATED  
SP-TI-3-1  
CORNING, NY 14831

EXAMINER

JOHNSON, EDWARD M

ART UNIT	PAPER NUMBER
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1754

10

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

78400

**Advisory Action**

Application No.

09/685,384

Applicant(s)

HE ET AL.

Examiner

Edward M. Johnson

Art Unit

1754

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 29 and 31-34.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-28.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: The proposed amendment would replace lanthanum oxide with La-y-B-alumina, which would be a new issue requiring further search and/or consideration. Also, since the finally rejected claim was examined and considered as containing the limitation "wherein x is less than 2", the removal of that recitation and subsequent re-broadening of the claim would also be a new issue requiring further search and/or consideration.

Continuation of 5. does NOT place the application in condition for allowance because: The claims are not allowable for reasons already of record. It is argued that the claim as amended would be allowable. This is not persuasive since the amendment has not yet been entered (see above). It is argued that furthermore, although... with zirconia or lanthana. This is not persuasive because Applicant provide no evidence aside from a blind assertion that the disclosed catalyst of the prior art would be "inoperable" when used with the disclosed support materials. It is argued that the Examiner further states that Detling discloses... alumina support. This is not persuasive because Applicant does not claim a support "entirely made of" TiOx, as Applicant appears to suggest. Rather, Applicant claims a support which may or may not "comprise" TiOx, with open language, allowing for the possibility of other ingredients. It is noted that the features upon which applicant relies (i.e., a support "entirely made of" TiOx) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is argued that Applicants respectfully submit that merely because titanium or chromium are employed in catalyst of the prior art it does not necessarily follow that using... would have been obvious. This is not persuasive because Applicant does not appear to offer any rebuttal as to why the claimed materials would have been unobvious to one of ordinary skill despite the fact that they are disclosed as well known and functional for the disclosed function of the cited prior art, "catalytic oxidation of halogenated organic compounds" (see *Nguyen* '636, column 1, lines 36-43). The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). It is argued that *Nguyen* discloses a catalyst having an alkaline earth... with Pt. This is not persuasive because Applicant does not claim a support wherein lanthanum is a "main component". Rather, Applicant claims that the support may or may not "comprise" lanthanum (see *In re Van Geuns*, above).

